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Re Patent Application of: Neal Luginbill  
et. al

Serial No.: ~~10/037597~~  
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Examiner: Jack  
Chiang

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with Attorney 6-13-06  
Y*

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**APPELLANTS' BRIEF (37 CFR § 43.37)**

This brief is submitted in triplicate. Please charge \$500.00 to our Deposit Account No. 18-0160 (reference order No. HRA-12807) to cover the fee referenced in 37 CFR § 41.20(b)(2). If any additional fees or extensions are required for this filing, please consider this as a request for extension and charge such additional required fees to our Deposit Account No. 18-0160, our order No. HRA-12807.

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This brief contains the items under the following headings in the order set forth below:

- I. REAL PARTY IN INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF CLAIMED SUBJECT MATTER
- VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
- VII. ARGUMENTS
- VIII. CLAIMS APPENDIX
- IX. EVIDENCE APPENDIX (none)
- X. RELATED PROCEEDINGS APPENDIX (none)

**I. REAL PARTY IN INTEREST**

Honda Giken Kogyo Kabushiki Kaisha, having a place of business at 1-1 Minamiaoyama 2-chome, Minato-ku, Tokyo, Japan is the real party in interest and the assignee of all right, title, and interest to the invention throughout the world. An assignment from inventors Neal W. Luginbill, Taro Shimokobe, Yuri Starik, and Marek Myszkowski has been recorded with the United States Patent and Trademark Office and can be found at Reel 012804 and Frame 0223.

**II. RELATED APPEALS AND INTERFERENCES**

Applicant does not know of any related appeals and/or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**III. STATUS OF CLAIMS**

A. Total Number of Claims in Application

Thirteen claims are currently pending in this application.

B. Status of the Claims

1. Claims previously canceled: Claim 2.
2. Claims withdrawn from consideration but not cancelled: None.
3. Claims pending: 1 and 3-14.
4. Claims allowed: None.
5. Claims rejected: Claims 1 and 3-14.
6. Claims objected to: None.
7. Claims indicated as allowable if the § 112 rejections are overcome: None.

C. Claims on Appeal

The claims on appeal are: Claims 1 and 3-14.

**IV. STATUS OF AMENDMENTS**

A Response to the Final Office Action of December 8, 2004 was filed on March 2, 2005, but did not include any amendments to the claims. The Examiner has indicated in an Advisory Action dated March 16, 2005 that the Response did not place the application in condition for allowance.

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

The presently claimed invention relates to a phone holder that includes an outer member and an inner member. The inner member is slidably and releasably received within the outer member. When the inner member is removed from the outer member, the outer member is adapted to receive a

phone having a first size and, when the inner member is received within the outer member, the inner member is adapted to receive a phone having a second size. *(Specification paragraph [0005])*

The outer member 78 integrally includes a main body member and an upstanding support. The main body member includes a U-shaped bottom wall 102, a pair of sidewalls 104, a bifurcated front wall 106, a rear wall 108, and a peripheral upper flange 110. The bottom wall 102 and front wall 106 define a slotted opening to permit a power cord to extend upwardly to a mobile telephone received within the outer member 78 and to permit a front face or display of the mobile telephone to be visible when the mobile telephone is received in the holding assembly. The bottom wall 102 further defines a pair of slots 112 through which alignment ribs 114 projecting downwardly from the insert member 100 extend. *(Specification paragraph [0034])*

The sidewalls 104 define opposed openings 116 that are downwardly adjacent the upper flange 110 and releasably receive resilient mounting ears 118 extending from the insert member. *(Specification paragraph [0035])*

A peripheral rim 134 surrounds the upper end of the inner member walls 126, 128, 130 and the upstanding wing. The peripheral rim 134 has an outer edge that preferably engages an upper inner peripheral surface of the outer member 78 and is inwardly adjacent the peripheral flange 110 of the outer member 78. *(Specification paragraph [0040])*

The outer member 78 is secured to a front panel member 36 by inserting a hook-shaped mounting tab 82 through a mounting opening 80 and then pivoting or rotating the outer member 78 toward the front panel member

36 to insert the attachment arms 120 through the associated first and second mounting openings 70, 72. (*Specification paragraph [0037]*)

## **VI. GROUND OF REJECTION**

1. Claim 1 stands rejected under 35 USC 103(a) as being unpatentable over U.S. Patent 5,745,565 to Wakefield in view of U.S. Patent D460962 to Peiker.
2. Claims 3-4 stand rejected under 35 USC 103(a) as being unpatentable over U.S. Patent 5,745,565 to Wakefield in view of U.S. Patent D460962 to Peiker and further in view of U.S. Patent 6,263,080 to Klammer et al.
3. Claims 5-6 stand rejected under 35 USC 103(a) as being unpatentable over the combination of U.S. Patent 5,745,565 to Wakefield, U.S. Patent D460962 to Peiker and U.S. Patent 6,263,080 to Klammer et al. in further view of U.S. Patent 6,543,637 to Osborn.
4. Claims 7-8 and 14 stand rejected under 35 USC 103(a) as being unpatentable over U.S. Patent 5,745,565 to Wakefield in view of U.S. Patent 5,556,017 to Troy.
5. Claim 9 stands rejected under 35 USC 103(a) as being unpatentable over U.S. Patent 5,745,565 to Wakefield and U.S. Patent 5,556,017 to Troy in further view of U.S. Patent D460962 to Peiker.
6. Claims 10-11 stand rejected under 35 USC 103(a) as being unpatentable over the combination of U.S. Patent 5,745,565 to Wakefield, U.S. Patent D460962 to Peiker and U.S. Patent 5,556,017 to Troy in further view of 6,263,080 to Klammer et al.

7. Claims 12-13 stand rejected under 35 USC 103(a) as being unpatentable over the combination of U.S. Patent 5,745,565 to Wakefield, U.S. Patent 5,556,017 to Troy, U.S. Patent D460962 to Peiker and U.S. Patent 6,263,080 to Klammer et al. in further view of U.S. Patent 6,543,637 to Osborn.

## **VII. Arguments**

A. The Rejection of Claim 1 under 35 USC 103(a) as being unpatentable over U.S. Patent 5,745,565 to Wakefield in view of U.S. Patent D460962 to Peiker.

In order to establish a prima facie case of obviousness under 35 U.S.C. §103, the cited references must teach each and every claim limitation or element of the rejected claims. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The rejection of independent claim 1 is in error and should be reversed, because each and every limitation of the claimed invention is not taught or suggested by the combination of cited references.

The combination of the Wakefield and Peiker references fails to disclose a phone holder with an outer member and inner member wherein "when said inner member is removed from said outer member, said outer member is adapted to receive, via the open top thereof, a phone having a first size and, when said inner member is received within said outer member, said inner member is adapted to receive, via the open top thereof, a phone having a second size", as required. Wakefield does not specifically disclose outer and inner members adapted to receive phones of different sizes. Only one size of phone is shown in the Wakefield patent. Additionally, Peiker does not

teach a device adapted to receive phones of different sizes. Peiker only teaches an open front on the item holding the phone. Accordingly, the combination of Wakefield and Peiker does not teach or suggest all of the features of the claimed invention.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *In re Geiger*, 815 F.2d 686, 2 USPQ 2d 1276 (Fed. Cir. 1987).

There is no motivation or suggestion in the art of record to combine the Wakefield and Peiker references in the manner proposed by the Examiner. Claim 1 includes an open topped inner member that is slidably received within an open topped outer member. Both the inner and outer members include a front wall that has an elongated opening therethrough. Only Figure 5 in Wakefield shows an embodiment of the Wakefield device with an outer and inner member. Unlike the device of Peiker that simply holds a phone, Wakefield teaches a dual function device, configured to hold first, a beverage container or alternately, a removable inner member that secures a cellphone. To provide the outer member of Wakefield with the open face disclosed by Peiker would severely limit its dual function capabilities. Providing any opening in the face of the outer member of Wakefield, creates instability when functioning as a beverage holder. The opening would allow for a beverage container to be inserted in an angled manner or would not provide the necessary support for more structurally weak containers, such as paper and plastic cups. There is simply no reason for one having ordinary skill in the art to modify a device in such a way that would detrimentally affect one of the

device's primary functions. Thus, it is considered apparent that a prima facie case of obviousness has not been established for claim 1.

B. The Rejection of Claims 3-4 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,745,565 to Wakefield in view of U.S. Patent D460962 to Peiker and further in view of U.S. patent 6,263,080 to Klammer et al.

In order to establish a prima facie case of obviousness under 35 U.S.C. §103, the cited references must teach each and every claim limitation or elements of the rejected claims. None of the references, alone or in combination, teach both an inner and outer member that include a bottom wall with an opening therein as required. Rather, Wakefield teaches a cup holder and phone holder, both with bottom walls that have no openings therein. Peiker teaches a cellular telephone holder having a bottom wall without an opening therein. Klammer teaches a unitary holding device that includes a slotted bottom for the passage of a power cord. The unitary holding device does not include an inner and outer member with bottom walls with openings therein.

Additionally, specifically with regard to claim 4, neither reference teaches that the inner member has ears that "snap fit through openings in the outer member", as required. The ridges 64 of Wakefield are not received in openings. Neither Peiker nor Klammer disclose or suggest any such structure. Rather, Peiker discloses a structure without outer and inner members. Klammer teaches a holding device and a carrier, neither including ears that snap fit through openings in the other. Accordingly, the combination of



Wakefield and Peiker and Klammer does not teach or suggest all of the features of the claimed invention.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. As previously stated, there is no motivation in the art to combine the Wakefield and Peiker references. Additionally, there is no motivation in the art to combine the Wakefield and Klammer references in the manner proposed by the Examiner. The Wakefield patent is directed toward a combination cup holder and phone holder. The Wakefield assembly is completely passive, and, thus, has no moving parts. Moreover, the Wakefield assembly is adapted to hold a phone such that the phone is exposed and accessible. On the other hand, the Klammer patent teaches a cradle for releasably receiving a corded phone. One skilled in the art, when trying to improve upon the Wakefield design, would not look to movable assemblies dedicated to a single size phone, such as Klammer. It is clear that the present application provides the only motivation for the proposed combination of references and, as such, the rejection of claims 3 and 4 is invalid for hindsight.

Further, insofar as none of the references disclose or suggest the desirability of accommodating different phone sizes, it is submitted that there is no motivation to combine the references in the manner that will achieve this result.

C. The Rejection of Claims 5-6 under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent 5,745,565 to Wakefield, U.S.

Patent D460962 to Peiker and U.S. patent 6,263,080 to Klammer et al. in further view of U.S. Patent 6,543,637 to Osborn.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. As previously stated, there is no motivation to combine the Wakefield and Peiker or Wakefield and Klammer references.

Further, there is no motivation or suggestion to combine the Wakefield, Peiker or Klammer references with Osborn in the manner proposed by the Examiner. The references are directed toward solving different problems. Osborn teaches ribs used for reinforcement on an adapter that is flexible and adjustable due to a number of vertical slots included therein. The ribs provide some resiliency to the adapter but do not function to align the adapter within a support. One looking to improve the devices of Wakefield or Klammer by making them alignable, such that they fit together with a consistent orientation, would not look to the teaching of Osborn which is not concerned with alignment. Peiker is not concerned with multiple element alignment, as only a single element is disclosed in the patented design. The present application provides the only motivation for the combination. Thus, it is considered apparent that a prima facie case of obviousness has not been established for claims 5-6.

In order to establish a prima facie case of obviousness under 35 U.S.C. §103, the cited references must teach each and every claim limitation or elements of the rejected claims. None of the references, alone or in combination, teach ribs within an inner member bottom wall and slots in an

outer member bottom wall. Rather, Wakefield teaches inner and outer member bottom walls that are ribless and slotless. Peiker teaches only a single member, not an inner plus outer member. Klammer teaches a holding device and a carrier, neither including ribs in a bottom wall. As stated above, Osborn does not disclose alignment ribs that extend into slots of an adjacent member. Instead the ribs disclosed serve a reinforcement purpose and the slots disclosed allow the section into which they are formed to be compressed as necessary. Accordingly, the combination of Wakefield, Peiker, Klammer and Osborn does not teach or suggest all of the features of the invention claimed in claims 5-6.

D. The Rejection of Claims 7-8 and 14 under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent 5,745,565 to Wakefield, in view of U.S. Patent 5,556,017 to Troy.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. With regard to claim 7, there is no motivation or suggestion in the art of record to combine the references in the manner proposed by the Examiner. The Examiner states that it would have been obvious to add a pivotal panel, as shown in Troy, to the device of Wakefield. Applicant does not see how this can be done. Wakefield teaches a holder that fits into an existing vehicle beverage holder. The holder is put in place when needed and removed when the beverage holder is used for its original purposes. If the holder is attached to a pivoting panel, it would no

longer be fit into a beverage holder, but rather pivoted into a storage bin as shown in Troy or a similar structure. Simply put, Wakefield does not suggest making such a modification. Rather, Wakefield teaches utilizing an existing vehicle beverage holder which is not pivotable, but level, and in so doing actually teaches away from such a change.

In order to establish a prima facie case of obviousness under 35 U.S.C. §103, the cited references must teach each and every claim limitation or element of the rejected claims. Even if the references were combined in the manner proposed by the Examiner, the present invention of claim 7 would not result. Wakefield does not disclose outer and inner members adapted to receive phones of different sizes, as required. Additionally, Troy does not disclose a panel that is "disposed generally vertically when said panel assembly is in a closed position" as required, but rather at an angle of about 45 degrees with respect to the bottom of the bin. Thus, the combination of Wakefield and Troy lacks this feature as well. Thus, it is considered apparent that a prima facie case of obviousness has not been established for claim 7.

Claims 8 and 14 depend directly from claim 7, which is allowable for the reasons stated above.

E. The Rejection of Claim 9 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,745,565 to Wakefield and U.S. Patent 5,556,017 to Troy in further view of U.S. Patent D460962 to Peiker.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion

or incentive supporting the combination. As previously stated, there is no motivation to combine the Wakefield and Troy references. Additionally, as previously stated, there is no motivation to combine the Wakefield and Peiker references. Thus, it is considered apparent that a prima facie case of obviousness has not been established for claim 9.

F. The Rejection of Claim 10-11 under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent 5,745,565 to Wakefield, U.S. Patent D460962 to Peiker and U.S. Patent 5,556,017 to Troy in further view of 6,263,080 to Klammer et al.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. As previously stated, there is no motivation to combine the Wakefield and Peiker and/or Troy references. Additionally, as previously stated, there is no motivation in the art to combine the Wakefield and Klammer references in the manner proposed by the Examiner.

Further, with regard to claim 11, neither reference teaches that the inner member has ears that "snap fit through openings in the outer member", as required. The ridges 64 of Wakefield are not received in openings. Peiker, and Klammer also do not include inner and outer members that are snappingly engaged as previously stated with regard to claim 4. Troy does not disclose a combination of an outer member and inner member. As will be apparent from the foregoing, the Examiner's proposed combination of

references fails to disclose or suggest the features of the invention defined in claims 11. Thus, it is considered apparent that a prima facie case of obviousness has not been established for claims 10-11.

G. The Rejection of Claims 12-13 under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent 5,745,565 to Wakefield, U.S. Patent 5,556,017 to Troy, U.S. Patent D460962 to Peiker and U.S. Patent 6,263,080 to Klammer et al. in further view of U.S. Patent 6,543,637 to Osborn.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. It is submitted that there is no motivation or suggestion to combine the references in the manner proposed by the Examiner. The references are directed toward solving different problems. Osborn teaches ribs used for reinforcement on an adapter that is flexible and adjustable due to a number of vertical slots included therein. The ribs provide some resiliency to the adapter but do not function to align the adapter within a support. One looking to improve the devices of Wakefield, Troy or Klammer by making them alignable would not look to the teaching of Osborn which is not concerned with alignment. The present application provides the only motivation for the combination. Peiker does not teach alignment of multiple elements.

Further, regarding claim 12, even if the references were combined in the manner proposed by the Examiner, the present invention would not result.

Additional modification of the combination would be required to arrive at the claimed invention. As previously stated with regard to claims 5-6, neither Wakefield, Peiker nor Klammer disclose ribs within an inner member bottom wall and slots in an outer member bottom wall. Troy also does not disclose ribs or slots, an only a single member, not an outer member and an inner member. As stated above Osborn does not disclose alignment ribs that extend into slots of an adjacent member. Instead the ribs disclosed serve a reinforcement purpose and the slots disclosed allow the section into which they are formed to be compressed as necessary. Thus, even the combination of Wakefield, Troy, Klammer, Peiker and Osborn does not teach alignment ribs and corresponding slots as required by claim 12. Therefore, claim 12, and claim 13 which depend therefrom, are patentable over the cited references.

### Conclusion

The prior art rejections of the cited claims should be reversed because the cited references alone or in combination do not disclose or suggest the invention recited in the claims. Specifically, the rejection of claim 1 under 35 USC 103(a) as being unpatentable over Wakefield in view of Peiker is in error. The rejection of claims 3-4 under 35 USC 103(a) as being unpatentable over Wakefield in view of Peiker and further in view of Klammer et al. is in error. The rejection of claims 5-6 under 35 USC 103(a) as being unpatentable over the combination of Wakefield, Peiker and Klammer et al. in further view of Osborn is in error. The rejection of claims 7-8 and 14 under 35 USC 103(a) as being unpatentable over Wakefield in view of Troy is in error. The rejection

## APPENDIX A

**Claim 1 (previously presented)** A phone holder, comprising:

an open topped outer member that is adapted to be releasably secured to a support; and,

an open topped inner member that is slidably received within the outer member, said inner member being releasably secured to said outer member;

wherein, when said inner member is removed from said outer member, said outer member is adapted to receive, via the open top thereof, a phone having a first size and, when said inner member is received within said outer member, said inner member is adapted to receive, via the open top thereof, a phone having a second size, and wherein each of said inner and outer members include a front wall that has an elongated opening through which a front of said phone is visible.

**Claim 2 (cancelled)**

**Claim 3 (previously presented)** The phone holder according to claim 1, wherein each of said inner and outer members include a bottom wall that has an opening through which a power cord of said phone extends.

**Claim 4 (previously presented)** The phone holder according to claim 3, wherein said inner member includes outwardly extending ears that are snap fit through openings in the outer member.



Claim 5 (previously presented) The phone holder according to claim 4, wherein said inner member bottom wall includes alignment ribs that extend into slots formed in the bottom wall of the outer member.

Claim 6 (previously presented) The phone holder according to claim 5, wherein the outer member includes an upper peripheral rim and the inner member includes an upper peripheral rim, said inner member peripheral rim being disposed inwardly adjacent said outer member peripheral rim when said inner member is received within said outer member.

Claim 7 (previously presented) A phone holding assembly, comprising:  
a panel assembly pivotally movable between a closed position and an open position wherein said panel assembly is disposed generally vertically when said panel assembly is in a closed position;  
an open topped outer member that is adapted to be releasably secured to said panel assembly; and,  
an open topped inner member that is adapted to be slidably received within the outer member, said inner member being releasably secured to said outer member;  
wherein, when said inner member is removed from said outer member, said outer member is adapted to receive, via the open top thereof, a phone having a first size and, when said inner member is received within said outer member, said inner member is adapted to receive, via the open top thereof, a phone having a second size.

**Claim 8 (previously presented)** The phone holding assembly according to claim 7, wherein said outer member includes a series of mounting tabs that are releasably secured within openings in the panel assembly.

**Claim 9 (previously presented)** The phone holding assembly according to claim 8, wherein each of said inner and outer members include a front wall that has an elongated opening through which a front of said phone is visible.

**Claim 10 (previously presented)** The phone holding assembly according to claim 9, wherein each of said inner and outer members include a bottom wall that has an opening through which a power cord of said phone extends.

**Claim 11 (previously presented)** The phone holding assembly according to claim 10, wherein said inner member includes outwardly extending ears that are snap fit through openings in the outer member.

**Claim 12 (previously presented)** The phone holding assembly according to claim 11, wherein said inner member bottom wall includes alignment ribs that extend into slots formed in the bottom wall of the outer member.

**Claim 13 (previously presented)** The phone holding assembly according to claim 12, wherein the outer member includes an upper peripheral rim and the inner member includes an upper peripheral rim, said inner member peripheral rim being disposed inwardly adjacent said outer member peripheral rim when said inner member is received within said outer member.

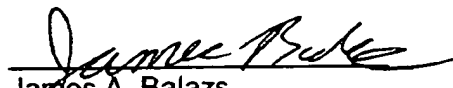
**Claim 14 (previously presented) The phone holding assembly according to claim 7, wherein said outer member being disposed generally vertically when said panel assembly is in said closed position.**

of claim 9 under 35 USC 103(a) as being unpatentable over Wakefield and Troy in further view of Peiker is in error. The rejection of claims 10-11 under 35 USC 103(a) as being unpatentable over the combination of Wakefield, Peiker and Troy in further view of Klammer et al. is in error. The rejection of claims 12-13 under 35 USC 103(a) as being unpatentable over the combination of Wakefield, Troy, Peiker and Klammer et al. in further view of Osborn is in error.

For the reasons set for the herein, the rejections of the claims 1 and 3-14 of the present application are in error and must be reversed.

Respectfully submitted,  
Rankin, Hill, Porter & Clark LLP

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